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10/021,983	12/13/2001	Arimasa Naitoh	JP920000323US1	2392

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EXAMINER

ELMORE, STEPHEN C

ART UNIT	PAPER NUMBER
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2186

8

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/021,983

Applicant(s)

NAITOH ET AL.

Examiner

Stephen Elmore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. It is noted that election was made **without** traverse in Paper No. 7.
2. Claims 1-4 and 19-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.
3. Claims 5-18 remain for examination.
4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Specification*

5. The disclosure is objected to because of the following informalities:
  - a. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title is not descriptive because it does not identify any novel features or characteristics of the claimed invention.Appropriate correction is required.

### *Claim Objections*

6. Claims 5-13 and 15-18 are objected to because of the following informalities:
  - a. the following limitations lack proper antecedent basis,
    1. claim 5, "said durable data storage device," "said first data storage device," "said first and said durable data storage devices";

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2. claims 8, 12, and 13, "said durable data storage device";
3. claim 9, "said durable data storage device" and "said first data storage device";
4. claim 15, "said low-power operation mode" and "the flow";
5. claim 16, "the supply," "said first and said second data storage devices," "said first data storage device," and "said second data storage device";
6. claim 17, "said first data storage device," and "said second data storage device";
7. claim 18, "said second data storage device";
- b. claim 15, "which controls of the flow" is non-idiomatic English;
- c. claims 6, 7, 10, 11 inherits the deficiencies of the previous claim in the claim dependency chain.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 5-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the scope of the following limitation in independent claim 5 (but which is not actually claimed)

limitation 1,

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*"wherein said controller selects alternative operating modes including a first mode which supplies electrical power to said first and said durable data storage devices, and a second mode which supplies electrical power to said durable data storage device while removing (emphasis added) electrical power to said first data storage device",*  
does not reasonably provide enablement for the following actually claimed limitation in independent claim 5, lines 7-10,  
limitation 2,

*"wherein said controller selects alternative operating modes including a first mode which supplies electrical power to said first and said durable data storage devices, and a second mode which supplies electrical power to said durable data storage device while suppressing (emphasis added) electrical power to said first data storage device."*

The difference in scope between the above two limitations are, the actual presently claimed scope includes the controller suppressing electrical power to the first data storage device, which, by the broadest reasonable meaning given to the term "suppressing", this scope covers reducing power in an amount that is less than all.

To reiterate, the limitation "suppressing electrical power" has the scope of meaning of removing some of the electrical power from the first storage device, while the limitation "removing electrical power" has the scope of meaning of removing all the electrical power from the first data storage device. These two limitations have different scopes of meaning because the scope of "some" is not equal to the scope of "all".

However, the specification only teaches, for example, at page 5, lines 17-20, "the second mode is used to supply electric power only to the second data storage device" which means that

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the present invention in independent claim 5 is only enabled for the scope of the limitation 1 - "removing electrical power" (removing all), and this means that the disclosure is not enabling for the full scope of limitation 2 - "suppressing electrical power" (removing less than all, some), because the disclosure does not teach removing less than all the electrical power from the second data storage device in the second mode.

Therefore, because the specification does not teach the full scope of claim 5 it does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and or use the invention commensurate in scope with this claim.

9. Claims 6-13 inherits the deficiencies of the independent claim from which they depend.

10. Claims 5-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In independent claim 5, the limitation,

*"a controller which controls access to said durable data storage device and which controls the flow of electrical power to said first and said durable data storage devices"*

is subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention containing this limitation because, as to this limitation, there is no teaching of such a controller which controls both:

1) access to said durable data storage device (such as a RAM memory controller controlling access to RAM),

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and which also controls,

2) the flow of electrical power to said first and said durable data storage devices (such as a power controller which controls power to a hard drive and RAM).

The disclosure taken as a whole fails to teach any such controller limitation having this scope of coverage for independent claim 5.

11. Claims 6-13 inherits the deficiencies of the independent claim from which they depend.

12. Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In independent claim 16, the limitations,

*"wherein said request receiver communicates a data read/write request to said power supply controller in response to the external request while said first and second data storage devices are powered off, and*

*said power supply controller maintains...and enables the reading/writing of data to said second data storage device in response to the data read/write request"*

are subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention containing these limitations because, in the instant disclosure there is no teaching that such a power supply controller receives the indicated data read/write request from the request receiver and then enables the reading/writing of data to the claimed storage device in response to the data read/write request, but the instant disclosure teaches only the functionality

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that the power supply controller controls the application of power to such storage device. The only element in the instant application which enables reading/writing of data to the claimed storage device is the memory controller of that device.

The disclosure taken as a whole fails to teach any such request receiver/power supply controller limitation having this scope of coverage for independent claim 16.

13. Claims 17 and 18 inherits the deficiencies of the independent claim from which they depend.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The scope of meaning of independent claim 14 is indefinite because in the limitation,

*"wherein said first and said second data storage devices are used as external storage for storing external data"*

it is not clear whether the scope of the limitation includes the first and second data storage devices to be external to the computer apparatus since the language "are used as external storage" appears to suggest that the data storage devices are external to the computer apparatus, however, the inclusive term "comprising" suggests that these data storage devices are internal to the computer apparatus, therefore, the existing language leads to contradictory suggestions or



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interpretations of the scope of the claim language, thus making one of ordinary skill unable to determine the intended scope of coverage of the claim's metes and bounds;

- b. claim 15 inherits the deficiencies of the independent claim from it depends.

*Allowable Subject Matter*

16. Claims 14 and 15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Elmore whose telephone number is (703) 308-6256. The examiner can normally be reached on Mon-Fri from 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on (703) 305-3821. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen Elmore  
Patent Examiner  
Art Unit 2186



June 13, 2004